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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

15854.3.1

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on _____

Signature _____

Typed or printed name _____

Application Number

10848809

Filed

2004-05-19

First Named Inventor

Steven C. Black

Art Unit

3629

Examiner

Shaun D. Sensenig

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

/John T. Gadd/ Reg. No. 52928

Signature _____

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

John T. Gadd

Typed or printed name _____

attorney or agent of record.

Registration number 52928

801-533-9800

Telephone number _____

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

October 7, 2009

Date _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)	
)	
Steven C. Black et al.)	
)	
Serial No.:	10/848,809) Art Unit
) 3629
Filed:	May 19, 2004)
)
Confirmation No.:	6228)
)
For:	AUTOMATED COMPLIANCE FOR HUMAN)
	RESOURCE MANAGEMENT)
)
Examiner:	Shaun D. Sensenig)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed July 6, 2009 (the "Final Office Action"), Applicants respectfully request a panel review of the final rejections under 35 U.S.C. §§ 101 and 103(a) discussed in the remarks below. An amendment after final canceling claim 35 was filed prior to this Request on October 6, 2009. This Request is being filed concurrently with a Notice of Appeal.

Claim 35 has been objected to for purportedly being in improper dependent form. Claims 1-10, 29-30, and 32-34 have been finally rejected under 35 U.S.C. § 101 for purportedly not being drawn to patent-eligible subject matter. Claims 1-11, 29-30, 32-33, and 35 have been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,330,817 B1 to Exall et al. ("Exall") in view of Peace Corps Applicant Toolkit ("PC"). Claims 15-18 have been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Exall in view of PC and further in view of U.S. Patent Number 6,067,522 to Warady et al. ("Warady"). Claim 34 has been finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Exall in view of PC and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks ("Jinks"). Claim 35 was canceled in a paper filed October 6, 2009 rendering moot the objection to, and rejection of, claim 35. Claims 12-14 and 23-28 were withdrawn and claims 19-22 and 31 were canceled in previous papers.

a. **Legal and Factual Deficiencies in Rejections Under 35 U.S.C. § 101**

In the Final Office Action, the Examiner repeated his rejection of claims 1-10, 29-30, and 32-34 under 35 U.S.C. § 101 for purportedly not being drawn to patent-eligible subject matter. Since the mailing on July 6, 2009 of the Final Office Action, however, the USPTO issued "Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101" ("*Interim Examination Instructions*").¹ These instructions "supersede previous guidance on subject matter eligibility" and include the following guidance:

An "article"...can also be electronic data that represents a physical object or substance. For the test, the data should be more than an abstract value. Data can be specifically identified by indicating what the data represents, the particular type or nature of the data, and/or how or from where the data was obtained.

"Transformation" of an article means that the "article" has changed to a different state or thing... A new or different function or use can be evidence that an article has been transformed... transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use.

Interim Examination Instructions, pages 5-6 (emphasis added).

Independent claim 1, from which all other claims rejected under 35 U.S.C. § 101 depend, recites an article, namely, electronic data arranged so as to define an electronic "human resources compliance form" that represents a physical object, i.e. a paper "human resources compliance form."² Applicants note that an electronic "human resources compliance form" represents both the visible data that appears on the physical paper form as well as non-visible data such as paper size of the physical paper form, positioning of visible data on the physical paper form, and size and position of whitespace, such as margins, on the physical paper form.

Claim 1 also recites acts that "particularly transform a particular article to a different state or thing." *See Interim Examination Instructions, page 5.* In particular, claim 1 recites acts that particularly transform at least one "human resources compliance form" to a different state by first "generating" a plurality of "human resources compliance forms" and then "updating" at least one of the "human resources compliance forms to conform with a change in the legal criteria."

This updating of at least one of the electronic "human resources compliance forms to conform with a change in the legal criteria" clearly qualifies as a particular transformation of a particular article under the *Interim Examination Instructions* because the updated form is suitable for a different use than the originally generated form. In particular, the updating of the originally generated form (to conform

¹ See Memorandum of Andrew H. Hirshfeld, "Effective Today: New Interim Patent Subject Matter Eligibility Examination Instructions," dated August 24, 2009.

² See discussion of physical paper "human resources compliance forms" on page 13-14 of Applicants' paper filed March 19, 2009.

with the change in the legal criteria) changes the nature of the original form from a form that is no longer legally compliant to a form that is legally compliant. A legally compliant form is suitable for a different use than a non-legally compliant form.

Therefore, at least because claim 1 transforms particular electronic data that represents a physical object into a different state, Applicants respectfully submit that claim 1, and corresponding dependent claims 2-10, 29, 30, and 32-34, are patent-eligible under 35 U.S.C. § 101. Accordingly, the rejections of claims 1-10, 29, 30, and 32-34 under 35 U.S.C. § 101 should be withdrawn.

b. Legal and Factual Deficiencies in Rejections Under 35 U.S.C. § 103(a)

Each of the rejected independent claims 1 and 11 recites "...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client..." Similarly, rejected independent claim 15 recites "...wherein an order in which the updated forms are made available to the client has been dynamically updated to accommodate the changes in the legal criteria..." (collectively the "order change elements").

In the Office Action immediately previous to the Final Office Action, the Examiner asserted that limitations similar to the above-cited limitations of claims 1, 11, and 15 are taught by *PC*. See *Office Action mailed December 19, 2008, pages 4 and 9*. Applicants responded to this assertion by arguing that *PC* does not teach these limitations. See *Applicants' Paper filed March 19, 2009, pages 15-16*. Then, in the Final Office Action, the Examiner conceded that *PC* does not explicitly disclose these limitations. *Final Office Action, pages 5 and 10*. However, instead of relying on another reference for these limitations, the Examiner appears to have opted to simply cite case law and rely on official notice in asserting that these limitations are obvious, alleging as follows:

...it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Exall so as to have included [determining whether the change in the legal criteria requires a corresponding change/updating the order in which forms are based on changes in legal criteria] in the order in which a form is presented to the client and presenting the forms in that order (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.") in order to ensure efficiency and reliability by not allowing the client to perform activities in an order that is legally non-compliant or to perform activities in an order that is considered to be procedurally inefficient or unnecessary, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Final Office Action, pages 5-6 and 10-11. The Examiner's assertions are defective for at least two reasons.

First, while the Examiner has relied on *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 as supporting the rejection under 35 U.S.C. § 103(a), the Examiner has failed to demonstrate any similarity between the facts of *KSR* and the facts in the present case. As the examination guidelines make clear "...legal precedent

can provide the rationale supporting obviousness only if the facts in the [cited] case are similar to those in the application." MPEP § 2144 (*emphasis added*). In particular, KSR dealt with whether a claim for a "vehicle control pedal apparatus" was obvious because it was a combination of demonstrably known elements (i.e. a support, an adjustable pedal assembly, a pivot, and an electronic control), that were combined according to demonstrably known methods, as demonstrated in specific prior art references.³

In contrast, in the present application, the Examiner has attempted to apply this legal precedent to claims for methods for facilitating the management of human resources compliance efforts, as well as claims for computer program products and user interfaces that implement methods for facilitating the management of human resources compliance efforts. The Examiner has not demonstrated how the method steps of the claims of the present application constitute the "combination of familiar elements according to known methods." Further, unlike KSR where the claim elements were each identified in cited references, the Examiner has failed to cite any prior art references that teach the purportedly "familiar elements." Although the Examiner assumes that the order change elements are "*familiar* elements," the Examiner's own concession that the cited references do not teach the order change elements is evidence that the order change elements are not "*familiar* elements." Therefore, inasmuch as the Examiner has failed to establish that the facts in KSR are similar to those in the present application, the rejection lacks an adequate foundation and should accordingly be withdrawn.

Second, the Examiner's apparent taking of official notice that the order change elements are "*familiar elements*" is improper in this case. As noted in MPEP 2144.03, "While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113." Therefore, it was improper for this official notice to be first taken in the Final Office Action. Further, MPEP 2144.03, directs that "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." (*Emphasis in original*). On the other hand, "it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence." *Id.*

Applicants respectfully submit that the order change elements are not capable of instant and unquestionable demonstration as being well-known, as are limitations to "make something faster, cheaper, better, or stronger." Instead, the order change elements involve specific technology that is capable of determining whether a change in certain legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to a client. Applicants submit that elements with this level of complexity are not properly rejected under 35 U.S.C. § 103(a) based merely on

³ See KSR at 1743 ("...we see little difference between the teachings of Asano and Smith and the adjustable electronic pedal disclosed in claim 4 of the Engelgau patent.").

a taking of official notice that these elements are well-known. Therefore, any rejections of claims including the order change elements must include a citation to a supporting prior art reference. Finally, the fact that the Examiner has been unable to produce a reference with the claim elements strongly suggests that the elements are not "*familiar* elements."

Accordingly, the rejections under 35 U.S.C. § 103 of claims 1, 11, and 15, and the rejections of claims 2-10, 16-18, and 32-34 which depend therefrom, should be withdrawn.

Dated this 7th day of October, 2009

Respectfully submitted,

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